



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,076	10/27/2000	Nicos A. Pctasis	06666/005002	9032

7590 07/14/2004

Scott C. Harris
FISH & RICHARDSON P.C.
4350 La Jolla Village Drive, Suite 500
San Diego, CA 92122

EXAMINER

SHIBUYA, MARK LANCE

ART UNIT	PAPER NUMBER
----------	--------------

1639

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/699,076

Applicant(s)

PETASIS ET AL.

Examiner

Mark Shibuya

Art Unit

1639

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 12 April 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): _____. *The proposed amendment would overcome the New Matter rejection under 35 USC 112.*
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see Note below.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 12, 18-21, 29, 35-39 and 43.Claim(s) withdrawn from consideration: 34 and 40-42.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


PADMASHRI PONNALURI
PRIMARY EXAMINER

See attached paper

Note Attached to Advisory Action

1. The proposed amendments will not be entered because they raise new issues that would require further consideration and/or search. Claim 1 may be read to be drawn to a combinatorial library of a plurality of compounds, where only one of the plurality of compounds is made by the claimed process. Proposed amended claim 1, drawn to a combinatorial library of a plurality of compounds, wherein the plurality of compounds in the combinatorial library are prepared by the claimed process, would therefore change the scope of the claim, and thus would raise new issues for consideration and search.

The effects of the proposed amendments to claim 38, on the restriction / election requirements, mailed 3/27/02 and 10/17/02, are unclear and would require further consideration.

2. The request for reconsideration has been considered but does not place the application in condition for allowance because the compounds of Formula I, II and III, as taught by Palfreyman et al., (U.S. 4,421,767), anticipate claim 12. Applicant argues that the examiner mischaracterizes said Formulae as a library of compounds, rather properly characterizing the Formulae as a Markush group representation of individual compounds. Applicant, in the Remarks after final rejection, argues that the specification teaches that:

the compounds in the library are related by location –whether as members of a common mixture, individual compounds distributed in a common array, or as members distributed in subpools –and by preparation, according to the methods described in the specification.

The Remarks after final rejection, at pp. 10-11.

Applicant's arguments have been considered but are not persuasive. The specification states:

Combinatorial libraries may be made as mixtures of compounds, or as individual pure compounds, generally depending on the methods used for identifying active compounds.

Specification at p. 7, lines 16-18. Thus the specification discloses that combinatorial are not necessarily composed of mixtures of compounds, but can be a set of individual, pure compounds.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., compounds in a library are related by location and by preparation) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is further noted that claim 1 is drawn to a plurality of compounds, where one or more of the plurality of compounds in the combinatorial library are prepared by the claimed process. The reference of Palfreyman et al., at col. 7, lines 47-49, teach that the compounds of Formula I, II or III may be used in combination with aromatic-L-amino acid decarboxylase (AADC). Thus the reference of Palfreyman et al., further anticipate claim 1, in teaching a plurality of compounds (AADC plus Formula 1, II or III), where one of the plurality of compounds is prepared by the claimed process.